

Legal Standards For Rejecting Claims  
Under 35 U.S.C. §§102 and 103

Applicants have set forth the legal standards for rejecting claims under Sections 102 and 103 in their responses to previous office actions. Therefore those standards will not be repeated here. Applicants specifically incorporate herein the previously stated legal standards.

Argument:

Re the Rejections of Claims 1, 5, and 6:

The examiner rejected claims 1, 5, and 6 under 35 U.S.C. §102(b) as being anticipated by, or in the alternative, under 35 U.S.C. §103(a) as being obvious over Menke. The examiner's rejections are improper in that Menke fails to disclose each and every limitation contained in the rejected claims. Menke also fails to provide the suggestion or incentive required to modify Menke in a manner that would make obvious the pending claims. Accordingly, the Patent Office has failed to establish the required *prima-facie* cases of anticipation and obviousness.

The Rejections Under section 102:

Claim 1 requires that the first and second cartridge receiving devices "together occupy a volumetric space within the frame" and that the third cartridge receiving device occupies "substantially the same volumetric space within said frame as is occupied by said first and second cartridge receiving devices in said first component configuration."

In supporting the rejection of claim 1 under Section 102(b) as being anticipated by Menke, the Patent Office construes claim 1 according to an "open interpretation." This construction is unreasonably broad in that it effectively reads the limitation

"substantially the same volumetric space" to include significantly greater volumetric space. That is, the Patent Office admits that the upper magazine 4 of Menke (illustrated in Figure 20) occupies significantly more space than two adjacent drives 5 (illustrated in Figure 21). Therefore, the Patent Office must conclude, in order to support its anticipation rejection, that the term "substantially the same" includes "significantly greater."

In construing claim terms, the Patent Office is required to give claims their "broadest reasonable interpretation." MPEP 2111. In addition, the words of a claim must be given their plain meaning unless they are defined in the specification. MPEP 2111.01 Plain meaning refers to the meaning given to the term by those of ordinary skill in the art. MPEP 2111.01.

As previously argued by the applicants, the term "substantially the same" means what it says. That is the plain meaning of the term. The term is not otherwise defined to the contrary in the specification. Moreover, persons having ordinary skill in the art would not regard the term "substantially the same" to mean significantly greater, as required by the so-called "open interpretation" of the Patent Office. Stated simply, then, the Patent Office's "open interpretation" of the claim term is unreasonable, thus cannot be used to sustain an anticipation rejection of claim 1 under Section 102.

Dependent claim 5 is believed to be allowable over Menke in that it depends from claim 1, which is not anticipated by Menke.

Dependent claim 6 is allowable over Menke in that it depends from claim 1, which is not anticipated by Menke.

#### The Rejections Under Section 103:

In an alternative rejection, the examiner rejects claims 1, 5, and 6 under Section 103 as being obvious over Menke. As applicants understand it, these obviousness rejections are based on a "closed interpretation" of claim 1. Under the so-called "closed interpretation," the term "substantially the same" of

claim 1 is not met by Menke. Therefore, claim 1 is not anticipated by Menke. However, the Patent Office goes on to argue that it would have been obvious to one of ordinary skill in the art to "arrive at the claimed number of replaced parts in the course of routine experimentation and optimization as is notoriously well known in the art." This argument is erroneous in that Menke fails to provide the suggestion or motivation to so modify his device.

It is well-established patent law that when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. In re Kotzab, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000). Moreover, the hypothetical "person having ordinary skill in the art" is a person that thinks along the lines of conventional wisdom and is not one who undertakes to innovate, whether by extraordinary insights or by patient and often expensive systematic research. Standard Oil Co. v. American Cyanamid Co., 774 F.2d 448, 227 USPQ 293 (Fed. Cir. 1985).

While the Menke reference teaches a device for playing, recording, and issuing discs, Menke is completely silent as to the issues associated with the present invention, i.e., that of providing a reconfigurable cartridge processing module wherein a third cartridge receiving device occupies "substantially the same volumetric space within said frame as is occupied by said first and second cartridge receiving devices." Significantly, while Menke does disclose that various cartridge storage modules may be replaced with other types of modules, Menke fails to disclose, or even suggest, an arrangement in accordance with the claims of the present invention.

Moreover, because the hypothetical person having ordinary skill in the art is one who thinks along the lines of conventional wisdom, such a person would find no motivation in Menke to modify Menke's system to create the reconfigurable cartridge processing module of the pending claims. Stated another way, if Menke, who was inclined to innovate (i.e., not

think along the lines of conventional wisdom), failed to appreciate the modification and did not incorporate it in his own device, it cannot be said that a person not inclined to innovate would make such a modification.

5     Re the Rejections of Claims 2-4 and 10-20:

10     The examiner rejected claims 2-4 and 10-20 under 35 U.S.C. §103(a) as being obvious over Menke for the reasons stated in the office action. These rejections are improper in that Menke fails to provide the suggestion or incentive to modify his device in the manner required by the rejected claims. Accordingly, the Patent Office has failed to establish the required *prima-facie* case of obviousness.

15     Claims 2-4, by virtue of their dependencies from claim 1, require that the first and second cartridge receiving devices "together occupy a volumetric space within the frame" and that the third cartridge receiving device occupies "substantially the same volumetric space within said frame as is occupied by said first and second cartridge receiving devices in said first component configuration." Accordingly, applicants specifically  
20     incorporate the arguments presented above with respect to the allowability of claim 1 over Menke. Claims 2-4, then, are allowable over Menke at least because they depend from claim 1, which is allowable over Menke.

25     Menke also fails to make obvious the limitations contained in claim 10. That is, Menke fails to disclose or even suggest a reconfigurable cartridge processing module wherein a "third cartridge device in said second component configuration" substantially replaces "said first and second cartridge receiving devices in said first component configuration and vice-versa, so  
30     that a volumetric space occupied by said first and second cartridge receiving devices in said first component configuration is substantially occupied by said third cartridge receiving device in said second component configuration and vice-versa." Applicants make the same points with respect to claim 10 as were

made with respect to claim 1. That is, Menke would fail to provide for a person having ordinary skill in the art the suggestion or motivation required to modify Menke in the manner urged by the examiner.

5 As discussed above, Menke shows the replacement of various cartridge storage modules with other types of modules. However, Menke fails to disclose, or even suggest, an arrangement in accordance with the claims of the present invention. In addition, because Menke, who was inclined to innovate and not  
10 think along the lines of conventional wisdom, failed to appreciate the modification and did not incorporate it in his own device, it cannot be said that a person not inclined to innovate would make such a modification. Accordingly, claim 10 is not made obvious by Menke.

15 Dependent claims 11-13 are believed to be allowable over Menke in that they depend from claim 10, which is allowable over Menke.

Independent claim 14 is also allowable over Menke for substantially the same reasons as set forth above for claim 1. That is, Menke fails to disclose a reconfigurable cartridge  
20 processing module having a frame that defines first and second component configurations wherein a "third cartridge receiving means" (in the second component configuration) occupies "substantially the same volumetric space within said frame as is  
25 occupied by said first and second cartridge receiving means in said first component configuration." Clearly, in Menke, the third cartridge receiving device (e.g., item 4 in Figure 14, annotated) occupies more volumetric space than is occupied by the first and second devices (e.g., items 5 in Figure 15, annotated)  
30 in the first configuration. In addition to failing to disclose a device that meets the limitations of claim 14, Menke fails to even suggest an arrangement in accordance with claim 14. Put in other words, because Menke, who was inclined to innovate and not think along the lines of conventional wisdom, failed to  
35 appreciate the modification and did not incorporate it in his own

device, it cannot be said that a person not inclined to innovate would make such a modification. Accordingly, claim 14 is not made obvious by Menke.

Dependent claims 15 and 17 are believed to be allowable over Menke in that they depend from claim 14, which is allowable over Menke.

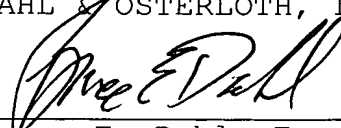
Method claim 20 is also allowable over Menke for substantially the same reasons as set forth above for claims 1, 10, and 14. That is Menke does not disclose, or even suggest, a method of defining a first component configuration by mounting first and second cartridge receiving devices to the frame and a second component configuration by mounting a third cartridge receiving device to the frame, the third cartridge receiving device "substantially replacing" the first and second cartridge receiving devices in the first configuration "so that a volumetric space occupied by said first and second cartridge receiving devices in the first component configuration is substantially occupied by said third cartridge receiving device in the second component configuration and vice-versa." Again, because Menke's third cartridge receiving device (e.g., item 4) occupies more volumetric space than the first and second devices (e.g., items 5), Menke fails to meet the limitations of method claim 20. In addition, a person having ordinary skill in the art would fail to find any motivation in Menke to modify Menke in the manner required by claim 20, because Menke himself failed to recognize the desirability of the modifications. Therefore, claim 20 is allowable over Menke.

Applicants believe that all of the claims pending in this patent application are allowable and that all other issues raised by the examiner have been rectified. Therefore, applicants respectfully request the examiner to reconsider her rejections and to grant an early allowance. If any questions or issues remain to be resolved, the examiner is requested to contact the

applicants' attorney at the telephone number listed below.

Respectfully submitted,

DAHL & OSTERLOTH, L.L.P.



Bruce E. Dahl, Esq.  
Attorney for Applicants  
PTO Registration No. 33,670  
555 17<sup>th</sup> Street, Suite 3405  
Denver, CO 80202-3937  
(303) 291-3200

Date: 7-8-03